



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,537	02/05/2002	James Dennis Wilson		1329

7590
James Dennis Wilson
106 N. Revere Rd.
Akron, OH 44333

04/09/2008

EXAMINER

BEKERMANN, MICHAEL

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

04/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/071,537

Applicant(s)

WILSON ET AL.

Examiner

MICHAEL BEKERMAN

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/17/2007 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1 and 9, these claims recite the limitation "past shopping behavior metrics for each product class as derived from past incentives redeemed, past incentives refused, and a plurality of items first scanned within a product class". The

Art Unit: 3622

specification discusses selecting incentives based on past shopping history, but the Examiner has found no recitation in the specification to account for selecting incentives based on past incentives redeemed. Further lacking from the specification are recitations directed towards selecting incentives based on past incentives refused and selecting incentives based on "a plurality of items first scanned".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 1 and 9, these claims recite the limitation "a plurality of items first scanned". This is unclear. It is possible for one item to be the first item scanned within a plurality of items. It is unclear how multiple items can be "first" scanned. It is further unclear as to how many items may be scanned and still be considered to be "first".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 7-13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211), and further in view of Christensen (U.S. Patent No. 5,710,886).

Regarding claims 1, 2, 4, 9, and 10, Deaton teaches delivering shopping incentives individually customized to influence each customer I(Column 4, Lines 50-54) in which the incentives are generated by a plurality of independently competing manufacturer controlled dynamic offer engines (Column 4, Lines 1-6, Figure 1, Reference 16, and Column 10, Lines 43-47) that customize each incentive to meet manufacturer objectives including market share (Column 4, Lines 45-49, Column 2, Lines 41-47, and Column 9, Lines 24-30). A manufacturer can't apply a marketing campaign for which funds are not available, and thus funding (budget) is inherently an internal concern for a company. Deaton determines the incentives based on currents purchases (scanned at a point of sale) (Column 4, Lines 50-54 and Column 9, Lines 37-38) and customer past purchase history (Column 4, Lines 50-54). Incentives based on current purchases take into account all products, regardless of their order of scanning, and thus reads on items that are "first" scanned or "last" scanned.

Deaton does not appear to specify a wireless scanning device. Sloane teaches a wireless device with a UPC bar code scanner used by the shopper to scan product bar codes in a store (Abstract). The device uses the bar codes scanned, along with consumer purchase history (shopper information) to determine an incentive for the user (Abstract). The incentive offered to the user could be a promotion for the product

scanned or a promotion for other competitive products (this is an example of competitive incentive offer engines) (Column 3, Lines 16-28). The user is able to select which promotional offers to be redeemed (Column 3, Lines 16-28). The wireless device can communicate the redeemed incentives to a point of sale (Column 3, Lines 48-59). It would have been obvious to one having ordinary skill in the art at the time the invention was made to give the consumer a portable device for discount offers instead of supplying the offers at the point of sale when the customer is already checking out.

While Deaton teaches informing the manufacturers of which coupons were redeemed (Column 4, Lines 15-19 and 37-40), neither Deaton nor Sloane appear to specify targeting incentives based on past incentives redeemed and past incentives refused. Christensen teaches a method of distributing coupons in which selecting the coupons is based on which coupons have been used in the past (past incentive redeemed) and which coupons have not been used (since the coupons were sent to the user and never redeemed, this equates to the a past incentive that was refused by the user) (Column 11, Lines 4-12). While Deaton and Sloane do not appear to specify using these specific methods of targeting, one of ordinary skill would have recognized that applying these old and well known targeting techniques (using information communicated in to the manufacturers in Deaton) would have yielded predictable results and resulted in an improved (and more targeted) incentive system.

Regarding claims 3, 5, 7, 11-13, 15, and 16, Deaton teaches Internet connection, wireless connections, and dedicated lines (Column 9, Lines 15-23). Sloane

Art Unit: 3622

teaches communication over radio frequency and cellular communications (Column 7, Lines 49-57).

Regarding claim 8, the circuitry contained within the device of Sloane is the same type of circuitry that could be found in a GPS, and therefore, Sloane's wireless device comprises GPS circuitry.

5. **Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211) and further in view of Christensen (U.S. Patent No. 5,710,886) and yet further in view of Anttila (U.S Patent No. 6,862,575).**

Regarding claims 6 and 14, Deaton, Sloane, and Christensen do not appear to specify a wireless device as generating a bar code to be scanned by a point of sale. Anttila teaches a wireless device that generates a scannable bar code (Column 5, Lines 6-10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow Sloane's device to generate bar codes to promote ease of use.

Response to Arguments

Due to amendments to the claim language and the new rejections applied with respect to those amendments, all arguments are rendered moot.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MB

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622